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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,400	11/28/2001	Geoffrey B. Rhoads	P0494	2368
23735	7590	12/01/2004	EXAMINER	
DIGIMARC CORPORATION 9405 SW GEMINI DRIVE BEAVERTON, OR 97008			TABATABAI, ABOLFAZL	
			ART UNIT	PAPER NUMBER
			2625	

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/997,400	RHOADS, GEOFFREY B.	
	Examiner	Art Unit	
	Abolfazi Tabatabai	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on application filed on November 28, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 6-9 is/are rejected.
- 7) ☒ Claim(s) 2-5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/24/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Moskowitz (U S 6,205,249 B1).

Regarding claim 1 Moskowitz discloses a method comprising digitally watermarking an image with a payload that represents at least two position coordinates for a point depicted within the image (column 6, lines 14-30).

Regarding claim 8 Moskowitz discloses a method comprising digitally watermarking different regions of an image with different watermark payload data, wherein a first region of the image is watermarked with payload data relating to an elevation of terrain depicted in said first region, and a second region of the image is watermarked with payload data relating to an elevation of terrain depicted in said second region (column 6, lines 14-30).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

4. Claim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by Rodriguez et al (U S 6,205,249 B1).

5. The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Regarding claim 7, Rodriguez discloses a method comprising digitally watermarking an image with a payload that includes first and second portions, said watermarking using a tiled approach, wherein uniformly-sized patches of the image are processed in accordance with the payload (column 6, lines 36-65), wherein the first portion is unchanging across all of said tiles, but the second portion changes between tiles (column 6, lines 36-65), so that position information about each tile can be determined therefrom (column 65, lines 3-29).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moskowitz (U S 6,205,249 B1) in view of Schipper et al (U S 5,987,136).

Regarding claim 6, Moskowitz is silent about the specific details regarding the method of claim 1 in which said position coordinates include latitude and longitude. In the same field of endeavor (watermarking), however, Schipper discloses image authentication patterning comprising position coordinates include latitude and longitude (column 15, lines 7-13).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use position coordinates include latitude and longitude as taught by Schipper in the system of Moskowitz because Schipper an improved system which will be useful where a digital image and its associated authentication is to be formed, preserved for later display and/or transmitted for use, analysis or display of the digital image by another user.

Claim 9 is similarly analyzed as claim 6 above.

Allowable Subject Matter

8. Claims 2-5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Other Prior Art

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bradley et al (U S 6,625,297 B2) disclose self-orienting watermarks.

Cox (U S 6,609,914) discloses watermarking of image data using MPEG/JPEG coefficients.

Nakano et al (U S 6,418,232 B1) disclose method of authenticating digital watermark pictures.

Carr et al (U S 6,389,151 B1) disclose printing and validation of self-validating security documents.

Rhoads et al (U S 6,614,914 B1) disclose watermarking embedder and reader.

Contact Information

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to ABOLFAZL TABATABAI whose telephone number is (703) 306-5917.

The Examiner can normally be reached on Monday through Friday from 9:30 a.m. to 7:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Mehta Bhavesh M, can be reached at (703) 308-5246. The fax phone number for organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Abolfazl Tabatabai

Patent Examiner

Group Art Unit 2625

November 24, 2004

A-Tabatabai